U.S. Application Serial No. 10/657,693
Applicant: Higgs

REMARKS

Applicant respectfully requests the Examiner to reconsider the present application in view of the above amendments and following remarks:

1. Rejection of Claims Under Section 103:

Claims 20, 22, 25, 26, 32, 34, 36 and 37 stand rejected under Section 103 as being unpatentable over the article entitled "Burlington Outlet Opens At Commons Chain Fills Void Left By Kmart," by Ron Maxey, published March 13, 1997 (hereinafter "Maxey") in view of the Wall Street Journal article dated Dec. 4, 2000 entitled "Promotional Ties to Charitable Causes Help Stores Lure Customers" (hereinafter "Zimmerman"). In particular, the Examiner asserts that Maxey teaches a method of promoting sales of goods and/or services at a shopping complex as specified in Claim 1, except that Maxey does not teach providing a physical microenvironment. The Examiner nevertheless asserts that Zimmerman teaches that aspect including a physical microenvironment along 20 blocks of Madison Avenue in New York including stores such as Armani and Zitomer.

Although the Examiner makes a number of other assertions with respect to the pending claims, Applicant will focus the initial discussion herein on Claims 22 and 34.

The Examiner asserts, in reference to Claims 22 and 34, that Maxey does not teach "an ongoing activity that is part of the normal ongoing activity" of the shopping complex. At the same time, the Examiner asserts that Zimmerman teaches that aspect of Applicant's claimed invention, wherein the Examiner asserts that the shopping card promotional program of Zimmerman is an "ongoing activity" lasting 9 days each year. The Examiner goes on to state that it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention in view of Zimmerman to modify Maxey to include a method wherein the activity is an ongoing activity that is part of the normal ongoing activity of the shopping complex.

Applicant respectfully disagrees with the Examiner's assertions and conclusions and provides the following arguments in support of patentability.

a. The Amendments Will Not Require Further Searching And Therefore Should Be Entered By The Examiner

First of all, for purposes of this Amendment After Final, and in response to the Final Office Action, Applicant has amended Claims 20 and 32 in a manner that would not require any further searching by the Examiner and therefore respectfully requests the Examiner to enter the above amendments notwithstanding that the Office Action is Final. The only changes that have been made to Claims 20 and 32 (that the Examiner has indicated would be given any patentable weight) are that the limitations set forth in original Claims 22 and 34 have been added to Claims 20 and 32, respectively, which is effectively the same as converting Claims 22 and 34 into independent claim form. Accordingly, Applicant respectfully submits that no amendments that would require the Examiner to conduct any further searching of any prior art have been made by this Amendment. Therefore, it is proper for the Examiner to enter the amendments herein.

It should be noted that in the Final Office Action the Examiner did not give any weight to the phrase "wherein the above steps are used to encourage said at least one retail tenant to occupy and lease said at least one space within said shopping complex, which in turn, helps to promote the sales of goods and/or services within said shopping complex," and therefore, Applicant respectfully submits that the Examiner should enter this amendment to Claim 32 -- as any language that is not given patentable weight should not affect the examination of the application.

b. Applicant's Claimed Invention Relates to Activities That are Ongoing; Zimmerman's Promotional Program Does Not

Applicant has amended Claims 22 and 34 in the manner described above because Applicant believes that the Examiner's characterization of the term "ongoing activity" is misplaced. To show that this is true, Applicant would like to direct the Examiner's attention to the definition of the word "ongoing," which, according to Webster's New World Dictionary, Second College Edition, copyright 1986, means something that is "going on, or actually in process; continuing, progressing, etc." Thus, an activity that is "ongoing" is one that is "actually in process, or continuing, or progressing, etc." And, given the arguments that the Examiner has made concerning the term "ongoing activity," the question is whether the shopping card program of Zimmerman which the Examiner admits lasts only 9 days out of the year can be considered an "ongoing activity."

Applicant respectfully submits that it cannot. In the first place, the activity in question is that portion of Zimmerman's program where customers are actually able to use the shopping card to buy products at a discount. As the Examiner admits, that portion of the "program" or "activity" lasts only 9 days out of a total of 365 days in the year – i.e., shoppers would not be permitted to receive the same discounts after the 9 day promotional program ends. That being the case, Applicant respectfully submits that Zimmerman's program, which is not ongoing for 356 days out of the year (365 days minus 9 days), cannot be considered an ongoing activity – as defined above – actually in process, continuing and progressing. Contrary to what the Examiner suggests, shoppers that want to use the shopping card under the Zimmerman program to receive discounts can only use it for 9 days out of 365 days, and cannot use it for the other 356 days, and therefore, such a program cannot be considered ongoing.

To support Applicant's position, Applicant would like to direct the Examiner's attention to a similar analogous circumstance that should show why the Examiner's conclusion is faulty. In Applicant's mind, to say that some activity that lasts only 9 days out of the year is an ongoing activity would be akin to saying that the actual competitive events of the Beijing Summer Olympics which lasts only 17 days out of the year and repeats itself once every four years is an ongoing activity. Although the Summer Olympics does repeat itself every four years, and there are a number of non-competitive activities and events that continue to occur during the year, the actual competitive events of the Summer Games only occur during a 17 day period, and they occur only once every four years, and therefore, they cannot be considered an ongoing activity.

Given the context in which the word "ongoing" is used in the claims, it should be clear that what Claims 20 and 32 are referring to is an "activity" that is "ongoing" which is different from an activity that lasts only 9 days out of the year.

For the above reasons, Applicant respectfully submits that Claims 20 and 32 as now amended are distinguishable over the prior art of record, including the combination of Maxey and Zimmerman, wherein Zimmerman only discloses a shopping card program that allows shoppers to receive discounts for 9 days out of a total of 365 days in the year -- and therefore – cannot be considered ongoing.

c. The Amendments Are Supported By the Specification

Applicant respectfully submits that the amendments made above relating to activities in the microenvironment that are ongoing are supported by the specification and therefore are proper and should be entered by the Examiner. On page 5, lines 8-13, of the specification, it states:

> "The microenvironment can also be altered during different seasons. In the above example, the rock climbing wall, putting green, indoor golf driving net, swim exercise pool, and underwater diving tank, can be offered during the summer months, while the simulated skiing and ice skating rink can be offered during the winter months. This way, the microenvironment can be geared specifically towards the particular goods and services that are likely to be popular during any given time of year (emphasis added)."

Also, the specification states: "Any of various activities can be rotated throughout the seasons depending on what kinds of goods and services are to be promoted." See page 11, line 22, to page 12, line 2.

Clearly, for the microenvironment to be "geared specifically towards the particular goods and services that are likely to be popular during any given time of year," and for the various activities to be "rotated throughout the seasons," the activity or activities that are offered in the microenvironment would have to be ongoing through the year. Plus, since Applicant's invention has to do with enabling shopping mall developers to attract the right kind of retail tenants, for the method to be effective, it can be inferred that the activities offered in the microenvironment would have to be offered throughout the year.

For these reasons, Applicant respectfully submits that Claims 20 and 32 are in condition for allowance and should be allowed.

Although Applicant believes there are additional grounds for distinguishing Applicant's invention over the prior art, because this rejection is under Final, Applicant will reserve those arguments for a subsequent case. For purposes of this application, Applicant respectfully submits that the amendments made and arguments submitted herein should be sufficient for purpose of overcoming the Examiner's rejections.

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2. Conclusion:

For the above reasons, Applicant respectfully submits that the claims pending in this application are in condition for allowance, and earnestly requests the Examiner to enter a Notice of Allowance in this case.

Very Truly Yours,

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